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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/757,917

01/14/2004

Daniel D. Snow

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11/02/2006

DAIMLERCHRYSLER INTELLECTUAL CAPITAL CORPORATION

CIMS 483-02-19

800 CHRYSLER DR EAST

AUBURN HILLS, MI 48326-2757

EXAMINER

VY, HUNG T

ART UNIT

PAPER NUMBER

.2163

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/757,917

Applicant(s)

SNOW ET AL.

Examiner

Hung T. Vy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. As of entry of the amendment filed 09/19/2006, claims 1-17 are pending in this application. Upon reconsideration, the Applicant's arguments are not persuasive (see response argument below).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8 and 10-17 are rejected under 35 U. S. C. § 102 (e) as being anticipated by Abdel-Malek et al. (U.S. patent No. 6,959,235).

Regarding claim 1, Abdel-Malek et al. discloses a method of assisting in correct diagnosis of a problem exhibited by a product having at least one component part, the method comprising: inputting to a database (MDSC 20) a description of the problem, a part identifier for the at least one component part, a description of the at least one component part, a product identifier, and at least one hint for assisting in diagnosing the problem (see fig. 1, 5 or column 16, line 30-45), generating a hint file (149) in the database and associating it with the at least one component part (see fig. 7); and downloading the hint file to a parts ordering system and a parts catalog system in association with the part identifier (see fig 1), such that whenever a request to order the at least one part is entered into the pads ordering system or an inquiry for the part is

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made to the parts catalog system, the hint will be displayed (see fig. 1 and column 9, line 39-67 and column 10, line 1-40).

Regarding claim 2, Abdel-Malek et al. discloses prior to the downloading of the hint file: forwarding the hind file to an authorized product team (42 or 142); and refining the hint file in accordance with inputs from the authorized product team (see fig 7).

Regarding claims 3-4, and 14, Abdel-Malek et al. discloses prior to the downloading of the hind file: forwarding the hind file to an approval organization (54); and proceeding to download only after approval of the hint file by the approval organization (see fig. 7 or column 9, line 7-35).

Regarding claims 5-6, 10-11, and 16-17, it is inherent that Abdel-Malek et al. discloses the displayed hind alerts a viewer that the problem with not be solved by replacement of the at least one component because Abdel-Malek et al. discloses the repair expert feedback the hind in the database and when retrieval the part and the problem, the displayed the information the part and how to solved (see column 9, line 40-65 and column 17, line 21-35).

Regarding claim 7, Abdel-Malek et al. discloses all limitations recited in claims 1-6 above (see rejection of claims 1-6).

Regarding claims 8 and 15, Abdel-Malek et al. discloses preventing a completion of placing an order for the at least one part until a requester enters an acknowledgement to the parts ordering system acknowledging that the hint has been displayed (see column 10, line 13-15).

With respect to claim 12, Abdel-Malek et al. discloses an arrangement for assisting in correct diagnosis of a problem exhibited by a product having at least one component part, the arrangement comprising: a database and associated database engine adapted to communicate with a plurality of organizations within an entity responsible for distributing the at least one component pad to product customers (see fig. 1-2), a parts ordering system (58) and a parts communication catalog system coupled for with the database and with at least one parts and service providing entity for the product (see column 10, line 5-40), wherein the database the plurality of organizations a description of the problem (see fig. fig. 1, 5, 7 or column 16, line 30-45), a part identifier for the at least one component part, a product identifier, and at least one hint for is operative to receive from at least one of assisting in diagnosing the problem, to generate a hint file in the database (149), associated with the at least one component pad and to download the hint file to the parts ordering system and the parts catalog system (see fig 1, 7), and wherein the parts ordering system and the pads catalog system are operative upon receiving a request or an inquiry for the at least one component from the at least one parts and service providing entity to display the hint to the at least one parts and service providing entity (see fig. 1 and column 9, line 39-67 and column 10, line 1-40).

With respect to claim 13, Abdel-Malek et al. disclose the plurality of organizations include a team of specialists for the product (142), wherein the database engine is further operative to forward the hint file to the team for refining the file (see fig. 7).

Claim Rejections - 35 U.S.C. § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 9 is rejected under 35 U.S.C. 103 (a) as being unpatentable over Abdel-Malek et al. (U.S. patent No. 6,959,235) in view of Demetriades et al. (U.S. Pub. No. 2004/0010578).

Regarding claim 9, Malek et al. discloses all limitation claimed invention recited in claim 7 excepted for translation service. However, Demetriades et al discloses the translation service (see paragraph 0161). It would have been to one of ordinary skill in art at the time the invention was made to implement Malek et al. 's system with the translation service in order to have different kind of country can have service with the same system and making the system more useful since such an arrangement with translation service for the stated purpose has been well know in the art as evidenced by teaching of Demetriades et al. (see paragraph 0161).

Response to Arguments

5. Applicant's arguments filed on 09/19/2006 have been fully considered but they are not persuasive. Applicant made the following arguments:

a. "Abdel-Malek is concerned with providing a technician with quick and easy access to detailed repair information. Abdel-Malek does not disclose or suggest the system as claimed including the automatic display of a hint when a

part is ordered. Instead, abdel-malek merely includes providing access to database information, with is common is the prior art. Because the prior art fails to teach each and every limitation of claims 1 and 7, namely an automatic display of a hint whenever a request or inquiry is made for a part, claims 1 and 7 are believed to be allowable. Claims 2-6 and 8-11 depend from claims 1 and 7 and are believed to be allowable for at lest this reason.” page 9, third full paragraph.

b. “Regarding claim 10, the Office Action alleges that Abdel-Malek inherently discloses a displayed hint alerting a viewer that a problem will not be solved by replacement of a component. However, the Applicants find no support for this assertion. Abdel-Malek includes a typical system that provides research tools for a technician. Abdel-Malek does not teach or suggest a visual alert indicating that replacing a part will not solve a particular problem as claimed. Such a visual alert saves time and resources by eliminating need of research into determining whether a part replacement will in fact solve the problem. As Abdel-Malek is not directed to such research avoidance visual alerts, it is unclear as to how this visual alert can be inherently disclosed. Because claim 10 includes an element not contemplated by the prior art, claim 10 is believed to be a new and non-obvious. For at least this reason and the reasons set forth above, claim 10 is believed to be allowable” page 9 last full paragraph.

c. “Regarding claim 15, the Applicants have thoroughly reviewed Column 10, lines 13-15 and find that Abdel-Malek fails to teach or suggest preventing completion of an order for a part until receipt of a signal acknowledging a display

of the hint as claimed. Instead, Column 10, Lines 13-15 state that: " repair parts ordered for a specific repair are matched with the locomotive configuration to ensure the correct part is obtained." Merely matching of parts is not equivalent to preventing completion of an order until a signal is received acknowledging a display of a hint. The claimed signal requirement acts as a failsafe for situations where the hint indicates that the part should not be replaced. Because the limitations of claim 15 are not disclosed or suggested by the prior art, claim 15 is believed to be allowable for at least this additional reason." page 10, second full paragraph.

In response to Applicant's argument a above, the Applicant's arguments are not persuasive because Abdel-Malek, in fig. 1, discloses depending upon the nature of the fault or anomalous condition, the on-board monitor automatically transmits this information back to the MDSC 20, where a repair recommendation is formulated and then made available to the portable unit 14 so Abdel-Malek interprets claimed "the automatic display of a hint when a part is ordered" as identifies faulty components (part is ordered) and provides fault codes for use by the repair technical in diagnosing the problem (hint). Further, the claim 1, feature "the automatic display of a hint when a part is ordered" was not officially claimed in Applicant's claim. Therefore, this argument is moot or not persuasive.

In response to Applicant's argument b above, the Applicant's arguments are not persuasive because in the abstract, Abdel-Malek discloses the repair recommendations and the supporting documents are available to the technician via a remote unit, thereby

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allowing the technician to access the repair steps and supporting documentation (visual, displayed) while the repair is in progress. Further, Abdel-Malek discloses in column 6, line 65-68 or column 7, line 1-5, the perform diagnosis, maintenance or repair services clearly stipulates that the replacing or no replacing of part relates of repair as illustrates.

In response to Applicant's argument c above, the Applicant's arguments are not persuasive because Abel-Malek discloses repair parts ordered for a specific repair are matched with the locomotive configuration to ensure the correct part is obtained equivalent to preventing completion of an order for a part until receipt of a signal acknowledging a display of the hind. Abel-Malek teaches both a confirmation process before part ordered.

The applicant's arguments about the rejection 112 are not persuasive because in the office action mailed out 6/30/2006, clearly disclose the motivation. The rejection 112 is proper and claim 9 is therefore believed to not patentable.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung T. Vy whose telephone number is (571) 2721954.

The examiner can normally be reached on 8-5.

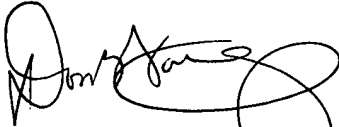
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don K. Wong can be reached on (571)2721934. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hung T. Vy
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October 23, 2006.

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DON WONG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100